

REMARKS/ARGUMENTS

Claims 16-19 and 28-30 are pending herein. Claims 11-15, 20, 21, 23, 24, 26 and 27 have been canceled without prejudice or disclaimer in response to the Restriction Requirement. Claim 16 has been amended as supported by original specification page 7, lines 13-21, for example. Claim 17 has been amended for clarification purposes only. New claims 28-30 are added hereby as supported by original specification page 17, line 5 -- page 18, line 9, for example.

1. Applicants hereby affirm the provisional election to prosecute claims 16-19 in the present application. The non-elected claims have been canceled without prejudice or disclaimer. Applicants presently intend to file a divisional application for the non-elected claims, and thus reserve the right under 35 U.S.C. §121.

2. Claims 16-19 were rejected under §102(b)/§103(a) over Tanahashi et al. To the extent that this rejection might be applied against the amended claims, it is respectfully traversed.

Pending independent claim 16 recites, among other things, a vibration damping rubber member having an island-sea structure in which fine particles of a vulcanized rubber material (B) are present as a dispersed phase in a matrix phase of a vulcanized rubber material (A). Pending claim 16 has been amended to clarify that the fine particles of vulcanized rubber material (B) have an average size of 0.1 to 100 μm .

Applicants were the first to discover that when fine particles of a vulcanized rubber material, in which the particles have an average size of 0.1 to 100 μm , are dispersed in a matrix phase of a vulcanized rubber material, it is possible to enhance the vibration damping characteristics of the vibration damping rubber member. The "fine particle" feature beneficially provides the damping member with a low degree of dynamic spring stiffness, while the vibration damping rubber member maintains a high vibration damping effect (see pending claim 16, lines 2-5 and original specification page 7, lines 13-21). Applicants respectfully submit that the applied prior art reference, Tanahashi, fails to disclose or suggest a vibration damping member having fine particles of a vulcanized rubber material, including the claimed average particle size range, dispersed in a vulcanized rubber matrix, as presently recited in independent claim 16 of the present application.

Tanahashi discloses a conductive rubber composition having suitable hardness and electric resistance characteristics for use in, for example, conductive rolls and conductive blades used in image forming devices. Consequently, Tanahashi is not concerned with the physical properties of the conductive rubber composition which pertain to the vibration damping characteristics of the composition.

As discussed above, pending claim 16 now recites a vibration damping rubber member including fine particles of a vulcanized rubber material (B), having an average particle size of 0.1-100 μm , dispersed in a matrix phase of a vulcanized rubber material (A). Again, Applicants discovered that fine particles with an average size of 0.1-100 μm dispersed in the matrix phase advantageously provides the vibration damping member with a low degree of dynamic spring stiffness, while insuring a high vibration damping affect. Applicants respectfully submit that skilled artisans would have had no reason to modify Tanahashi's rubber composition to include a dispersed phase of fine particles, as claimed, for any reason, let alone to provide the conductive rubber composition with enhanced damping characteristics (e.g., a low degree of dynamic spring stiffness). There certainly would have been no reason to adjust the average size of rubber particles in Tanahashi's composition to be between 0.1 and 100 μm , as claimed.

In view of all of the foregoing, reconsideration and withdrawal of the §102(b)/§103(a) rejection over Tanahashi are respectfully requested.

3. Claims 16-19 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 8-14 of U.S. Patent No. 6,465,607 (Taguchi et al.). Although Applicants disagree with the statement on page 6 of the Office Action that the only difference between the process steps claimed in the present application and the process steps recited in the claims of the '607 patent is the addition of a vulcanizing agent, a Terminal Disclaimer is filed herewith to obviate this non-statutory double-patenting rejection over the claims in the '607 patent.

4. Claims 16-19 were rejected under §103(a) over Taguchi et al. This rejection is respectfully traversed.

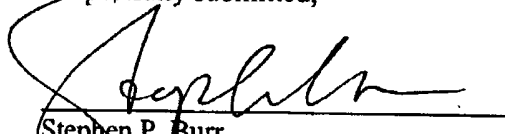
The present application is the National Phase of a PCT application filed on October 30, 2000. As such, the effective U.S. filing date for the present application is the international filing date of October 30, 2000. The effective date as a prior art reference for

the '607 patent, however, is the U.S. filing date of May 30, 2001. Since the international filing date of the present application is prior to the U.S. filing date of U.S. '607, the '607 patent is not prior art with respect to the present application under any paragraph of §102/§103. Accordingly, withdrawal of this rejection is respectfully requested.

If the Examiner believes that contact with Applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call Applicants' attorney at the phone number noted below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-1446.

Respectfully submitted,



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July 30, 2004

Date

SPB:SWC:jms

Attachment:

Terminal Disclaimer (and check for \$110.00)

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